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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,076	11/08/1999	DENISA D. WAGNER	10861/011003	6116

7590 11/16/2001
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EXAMINER

GAMBEL, PHILLIP

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 11/16/2001

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/436076

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EXAMINER

ART UNIT	PAPER NUMBER
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1644 20

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 6/7/01; 9/10/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 40-41, 45, 49-54, 56, 59-60, 73-74 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 40, 41, 45, 49-54, 56, 59-60, 73, 74 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-SEE OF

ON THE FOLLOWING PAGE

DETAILED ACTION

1. The examiner of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Technology Center 1600.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 9/10/01 (Paper No. 19) has been entered.

Applicant's previously unentered amendment, filed 6/7/01 (Paper No. 16), has been entered.

Claims 42, 53, 67-72 have been canceled.

Claims 1-39, 42-44, 46-48, 54, 55, 57, 58 and 61-66 have been canceled previously.

Claims 40, 45, 51, 56 have been amended.

Claims 73-74 have been added.

Claims 40-41, 45, 49-52, 56, 59-60 and 73-74 are pending.

3. Upon reconsideration and in order to consistent with copending application USSN 08/948,393; the following restriction has been set forth herein.

Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct methods relying upon patentably distinct products. The methods rely upon P-selectin ligands such as sialyl Lewis x, sialyl Lewis a, P-selectin, PSGL-1, 160 kD monospecific P-selectin ligand, P-selectin mimic or P-selectin mimic or antibodies thereto which differ in structure and modes of action to such an extent and require non-coextensive searches to such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various groups, irrespective of the format of the claims, because these are not proper species. Further, it is noted that pages 6-12 of the instant specification discloses a number of patentably distinct agents, which may be subject to further restriction and/or species election. Applicant is invited to clearly elect a single Group as it reads on a particular therapeutic agent and to provide an appropriate claim that reads on the elected invention. The Groups set forth below appear to read on the claims as currently recited, but may be subject to further Restriction and/or species election depending on the claimed recitation.

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis, wherein the PSGL is sialyl Lewis x classified in Class 514, subclass 23.
- II. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is sialyl Lewis a, classified in Class 514, subclass 23.
- III. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is P-selectin, classified in Class 514, subclass 8.
- IV. Claims 40-41, 45, 49-52, 56, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is PSGL-1, classified in Class 514, subclass 2.
- V. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is a 160 kD P-selectin ligand, classified in Class 514, subclass 2.
- VI. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is a P-selectin mimic, classified in Class 514, subclass 2.
- VII. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is P-selectin ligand mimic, classified in Class 514, subclass 2.
- VIII. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is derived from snake venom, classified in Class 424, subclass 542.
- IX. Claims 40-41, 49-52, 59-60 and 73-74, drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is derived from a plant extract, classified in Class 424, subclass 195.1.
- X. Claims 40-41, 49-52, 59-60 and 73-74 drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is P-selectin-specific antibody, classified in Class 514, subclass 8.
- XI. Claims 40-41, 49-52, 59-60 and 73-74 drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is PSGL-1-specific antibody, classified in Class 424, subclass 130.1.
- XII. Claims 40-41, 49-52, 59-60 and 73-74 drawn to methods of treating or inhibiting atherosclerosis or restenosis wherein the PSGL is a 160 kD P-selectin ligand-specific antibody, classified in Class 424, subclass 130.1.
- XIII. Claims 40-41, 49-52, 59-60 and 73-74 drawn to methods of treating atherosclerosis or restenosis wherein the PSGL is a mucin-like molecule, classified in Class 424, subclass 501.

6. Inventions I-XIII are different methods, which require patentably distinct ingredients. Therefore, they are patentably distinct. The claimed methods employ various PSGs which are distinct because their structures and modes of action are different, which require non-coextensive searches. These PSGs are different with respect to biochemical properties; including primary, secondary and tertiary structure. These molecules do not share a substantial structural feature essential to a common utility. Therefore, they are patentably distinct.

7. Because these inventions are distinct for the reasons given above and the search required for any Group from Groups I-XIII is not required for any other group from Groups I-XIII and Groups I-XIII have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.



Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
November 13, 2001